



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------------|
| 10/582,276 | 06/10/2006 | Maik Berger | HM-701PCT | 2815 |
| 40570 | 7590 | 09/15/2008 | | |
| FRIEDRICH KUEFFNER 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017 | | | EXAMINER BINDA, GREGORY JOHN | |
| | | | ART UNIT 3679 | PAPER NUMBER |
| | | | MAIL DATE 09/15/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/582,276

Applicant(s)

BERGER ET AL.

Examiner

Greg Binda

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/ICE)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Information Disclosure Statement

1. The listing of references in the specification as at pages 2 & 4-6 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to because:
- a. The reference character L appears at page 2, line 17, but does not appear in the drawings.
 - b. Reference numerals 5 & 11 are supposed to identify different elements, but they both point to the same element in Fig. 1.
 - c. The drawings fail to show the following claim limitations:
 - i. Claim 1: main drivetrains
 - ii. Claim 1: rolling stands
 - iii. Claim 1: a permanent seat
 - iv. Claim 1: internal toothing
 - v. Claim 1: a pressure gap
 - vi. Claim 1: pressure fluid
 - vii. Claim 7: shear collar 10 permanently connected to the spindle section 6

viii. Claim 7: “a shear valve”

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to as failing to comply with 37 CFR 1.77(c) for failing to include section headings.
5. The abstract of the disclosure is objected to because it includes phrases that can be implied (e.g. “The invention relates to” and “According to the invention”) and because it isn’t

written in clear narrative form. Instead it appears to be a literal translation of a foreign abstract. It needs to be rewritten in clear idiomatic English. Correction is required. See MPEP § 608.01(b).

Claim Objections

6. The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

7. The claims are objected to as failing to comply with 37 CFR 1.75(i) because elements of the claims are not separated by line indentation.

8. Claim 7 is objected to because the word "is" should be inserted at the end of line 7.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a. Claim 1, lines 8-10, recites the limitation, “a pressure sleeve 4 and a pressure gap 14 pretensioned with pressure fluid produce a nonrotatable connection”. The specification fails to teach how a nonrotatable connection is formed by the fluid. Fluid in the gap of a sleeve cannot by itself form a nonrotatable connection between elements that would otherwise be rotatably connected.

b. Claim 7, lines 5-7, recites the limitation, “a shear collar 10 . . . is also connected to a shear valve 11, so that the connection pretensioned by the pressure medium in the pressure gap 14”. However, Fig. 1 only shows the shear collar attached to a pressure sleeve 5. There is no explanation in the specification of how to make a shear valve in addition to this sleeve.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claim 1, the phrase "especially for" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- b. Claim 1, lines 5, 7 & 8 and claims 3, 4 & 7 recite the limitation, "the spindle section". It is unclear which of the previously recited spindle sections is "the spindle section".
- c. There is insufficient antecedent basis for the following limitations:
 - i. Claim 1, line 10: "the rear sleeve-like extension" in line 10.
 - ii. Claim 4, line 4: "the fixed bearing"
 - iii. Claim 4, line 5: "the movable bearing"
 - iv. Claim 4, lines 5 & 6: "the antirotation device"
 - v. Claim 4, lines 7 & 8: "the externally toothed part"
 - vi. Claims 5 & 6: "the cylinders"
 - vii. Claim 6: "the coupling action"
- d. Claim 4, lines 3 & 4 includes the nonsensical limitation, "the he direction".

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1 & 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hecke, US 5,141,350. Fig. 1 shows an overload safety coupling for a toothed spindle section 6 and a spindle section 18 with a permanent seat 16 comprising a rotating-and-sliding sleeve 8 which has internal toothing 40 at one end to hold the spindle section 6 in a way that allows axial movement (see "limited movement" in col. 3, line 8), whereas at the other end, it holds an inner sleeve 16, which is permanently seated on the spindle section 18, where a pressure sleeve 20 and a pressure gap 26 pretensioned with a pressure fluid (see "a suitable fluid" in col. 4, line 7) produce a nonrotatable connection between the rear sleeve like extension 34 and the inner sleeve 16, which frictional connection gives way in the event of an overload.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Binda/
Primary Examiner
Art Unit 3679